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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,116	09/29/2003	Peter J. Dronzek JR.	181-030B	2428

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HEDMAN & COSTIGAN P.C.  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER
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SCHATZ, CHRISTOPHER

ART UNIT	PAPER NUMBER
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1733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/674,116

Applicant(s)

DRONZEK, PETER J.

Examiner

Christopher T. Schatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-36 and 38-50 is/are pending in the application.
- 4a) Of the above claim(s) 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-36, 38-47, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Request for Continued Examination*

1. Applicant's Request for Continued Examination filed on October 27, 2006 is acknowledged by the examiner.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 49 recites similar steps as its independent claim, claim 25, however, claim 49, requires a specific density and further requires that said surface or container be plastic. However, the order of method steps recited is unclear to examiner. It is respectfully recommended that applicant simplify the language of claim 49 by removing the current claim language and replacing it with the following: "A method for labeling a glass, plastic or metal container as defined in claim 25 wherein step (a) further comprises selecting a microvoided polymeric label having a density of less than 0.9 and step (c) further comprises fastening said fastenable polymeric label to a plastic container or surface."
4. Claims 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The new claims require the selected polymeric label to have a density

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less than 0.9. However, the claims fail specify units for the required density. The specification also fails to recite specific density unit, and thus it is unclear to the examiner what units are associated with the claimed density. For the purposes of this office action, the examiner will assume that the density units are g/cc.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25-36, and 38-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dronzek (WO 99/19412) in view of Amberg '640 for the same reasons as set forth in section 6 of the Final Office Action dated June 27, 2006.

Applicant's Petition Under 37 CFR 1.78(a)(3) filed October 27, 2006 is acknowledged by the examiner. The Petition is currently under review. If applicant's Petition is granted, the rejection presented in section 5 of the Final Office Action dated June 27, 2006 will be withdrawn because Dronzek (WO 99/19412) will no longer qualify as prior art.

7. Claims 25, 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jannusch '884 in view of Amberg '640 for the same reasons as set forth in section 7 of examiner's office action dated December 13, 2005. Applicant has amended claim 25 to recite a polymeric label. Both Jannusch and Amberg disclose such a label. As to new claims 49 and 50,

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Amberg discloses that the density of the label is less than 0.9 g/cc (column 5, lines 1-12). As to claim 50, Jannusch discloses application of the label to a plastic surface (column 8, lines 30-33).

8. Claims 25-36, 38, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jannusch and Amberg as applied above, and in further view of Navikas '898 for the same reasons as set forth in section 8 of examiner's office action dated December 13, 2005.

9. Claims 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jannusch, Amberg and Navikas as applied above, and in further view of Kelly et al. for the same reasons as set forth in section 9 of examiner's office action dated December 13, 2005.

### *Response to Arguments*

Applicant's arguments filed October 27, 2006 have been fully considered but they are not persuasive.

As discussed above, applicant's Petition Under 37 CFR 1.78(a)(3) filed October 27, 2006 is acknowledged by the examiner. The Petition is currently under review. If applicant's Petition is granted, the rejection presented in section 5 of the Final Office Action dated June 27, 2006 will be withdrawn because Dronzek (WO 99/19412) will no longer qualify as prior art.

Applicant argues that because Amberg discloses a hot melt adhesive the foamed label of Amberg "appears" to be a closed cell label. It is unclear to the examiner why the applicant concludes that the use of a hot melt adhesive means that the foamed label is closed cell. The examiner respectfully asserts that applicant's statements with respect to Amberg are merely conjectures and not supported by scientific reasoning or evidence. Furthermore, regardless of the specific cell structure of Amberg, that fact that the label is foamed necessarily means that at least

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some water-based adhesive will migrate into the label. Page 3 of applicant's own Declaration supports this statement. Applicant's claim does not require a specific *amount* of adhesive to migrate. Regardless of whether or not the foam of Amberg is closed or open, *at least some* of the aqueous based adhesive of Jannusch will migrate into the label of Amberg. Applicant is respectfully notified that because the rejection is Jannusch in view of Amberg, it is not necessary for the Amberg to disclose that an aqueous based adhesive because Jannusch discloses an aqueous based adhesive. It is the position of the examiner that one of ordinary skill in the art in possession of both references would have readily recognized that replacing Jannusch's label with Amberg's foamed label is advantageous and when such a replacement is made the aqueous based adhesive of Jannusch will migrate into the foamed label of Amberg. Applicant's declaration that shows more adhesive will migrate into an open-celled foam structure than a closed cell structure is not commensurate with the scope of applicant's claims because that claims do not require a specific amount of adhesive to migrate as discussed above. The advantage of using a microvoided polypropylene label would apply to the method of Jannusch even though Jannusch uses a different adhesive than Amberg. The burden is on the applicant to prove otherwise.

Applicant states that Jannusch does not disclose polypropylene. Examiner asserts that Amberg does disclose polypropylene and further discloses that polypropylene is an alternative to polystyrene and thus examiner asserts that it would have been obvious to use polypropylene as the polymeric material in place polystyrene. Applicant further argues that "The Jannusch patent has been applied as a primary reference which infers that there is some teaching in the reference that directs the skill artisan to combine the Jannusch teachings with the Santiago teachings." The examiner has not cited a Santiago reference, and believes that the applicant intended to refer to

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the Amberg reference rather than Santiago. Applicant is respectfully notified that a primary reference need not recognize or acknowledge deficiencies with the method disclosed by said reference. Furthermore, the primary reference need not recognize or specifically refer to the secondary reference that said primary reference is combined with in order to form a proper rejection. The examiner asserts that Jannusch is combinable with Amberg because both references are concerned with applying a label to a surface via an adhesive.

Applicant further argues "there is no teaching or suggestion in Amberg that would lead a skill artisan to use a water based adhesive in place of the hot melt-heat shrinking method of applying a label." It is the position of the examiner, as stated in section 7 of the Final Office Action dated June 27, 2006, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the label of Amberg for use in the method of Jannusch because the label of Amberg would form a conforming fit around the bottle of Jannusch. The applicant is attacking Amberg as a primary rather than considering Amberg as a secondary reference to the method of Jannusch. Jannusch need not disclose a microvoided or foamed label because Amberg discloses both a microvoided and foamed label and provides a specific reason as to why one of ordinary skill in the art would have been motivated to use said label when labeling a bottle or other object. Thus, examiner asserts that hindsight has not been used and further asserts the references are combinable for the reasons discussed above.

As to claims 49 and 50, claim 50 does not require a density of 0.55-0.85 but rather only requires a density of less than 0.9. Amberg meets this density limitation as discussed above and applicant is respectfully notified that Amberg also meets the density range of 0.55-0.85. The heat shrinking step of Amberg does not exclude the use of plastic bottles because heat shrinking can

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still be preformed on a plastic bottle as long as the temperature is below the softening point of said plastic bottle. Applicant then states that Jannusch is defective as a primary reference.

Applicant is advised that one cannot show nonobviousness by attacking references individually and in a vacuum of each other as a rejection under 35 U.S.C. 103 is a consideration relating to the combined teachings of the references (and not each reference in a vacuum of the others).

As to Amberg, examiner asserts that any foamed material, whether or open-celled or not, will allow a water based adhesive to migrate into said material. Applicant further states that Amberg is only concerned with non-foamed material and thus is not combinable with Jannusch. Examiner respectfully asserts that Amberg is in fact concerned with foamed materials.

As to Navikas, the examiner is using the reference to show that one of ordinary skill in the art would have been motivated to apply a hydrophilic layer to a polymeric surface before bonding between said polymeric surface another surface is performed. Navikas is not concerned with the material of the label and said label's composition is not germane to the rejection at hand. None of applicant's arguments with respect to Navikas are commensurate with the scope of the claims because the claims do not require "polymeric label stock" and the claims do not mention "tack" and "label swimming."

As to Kelly, disclose of microvoided polymeric label is not necessary because Amberg discloses such a label as discussed above.

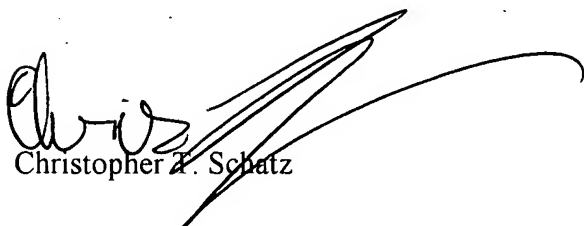



*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is **571-272-1456**. The examiner can normally be reached on 8:00-5:30, Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Christopher T. Schatz

  
**RICHARD CRISPINO**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER**